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09/526,547	03/16/2000	Jose Fedida	JEL-31040	1825

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EXAMINER

BUI, VY Q

ART UNIT	PAPER NUMBER
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3734

DATE MAILED: 10/24/2006

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APPLICATION NO./ CONTROL NO.	FILING DATE	FIRST NAMED INVENTOR / PATENT IN REEXAMINATION	ATTORNEY DOCKET NO.
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EXAMINER

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20061020

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Commissioner for Patents

Please, see attachement.

Vy Q. Bui
Primary Examiner
Art Unit: 3734

Response to Arguments

Applicant's arguments filed 08/01/2006 in the "Reply Brief" have been fully considered but they are not persuasive.

I. Claims 18, 19, 22, 26, 27, 29, 30, 33, 37, and 38 stand rejected under 35 USC §102(b), as being anticipated by or in the alternative, under 35 USC § 103(a) as being unpatentable over Goicoechea et al. (US-5,609,627).

1. The Applicant (Argument, page 4, paragraph 2 and 3) argued that the Examiner's Answer proposes that Goicoechea inherently discloses or obviously suggests that staple 99e is a "conventional staple used with a conventional stapler," such as that used in an office environment to hold sheets of paper together (Examiner's Answer, page 6, second and third paragraphs).", and "However, the Examiner's Answer fails to establish inherency".

In response, the Applicant is requested to look at Figs. 4B-4F and description of the Figures 4B-4F (Goicoechea-'627; col. 9, lines 53-61). Goicoechea-'627 refers to securing means as loop 99a of a suture material (Fig. 4B) or bead 99b (Fig. 4C) or loop 99c (Fig. 4D) or ring 99d (Fig. 4E) or staple 99e (Fig. 4F). It is clear that staple 99e must be different from loop 99a of a suture material, or bead 99b, or loop 99c as described by Goicoechea-'627.

Then, what does that mean by "staple" in Goicoechea-'627?

Conventionally, in a **linking position**, a staple has **one single straight portion/central portion** connecting **two loops at both ends of the central portion**. For simplicity and in order to relate the term "staple" of Goicoechea-'627 to some thing well known, the Examiner referred to a "staple", **for example, such as a staple** for keeping sheets of paper together in an office

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environment. Notice that there are references, which also clearly show staples in a **linking position** having one **single straight portion/central portion** connecting **two loops at both ends of the straight/central portion**. Please see **Graf-US Pat. 3,751,961's Figs. 8-9**, which show staple 82 links **wire 88** and **wire 92**, or **Conta et al.-US Pat. 3,751,961's Fig. 21**, which shows staple 159 also in a linking position or **Jarrett et al.-5,342,395's Fig. 2**, which show staple 12.

Goicoechea-'627 does not show or describe **explicitly** that in a linking position, staple 99e has one single straight/central portion connecting two loops at both ends of the straight/central portion as recited in the independent claims. Goicoechea-'627 does not need to explicitly describe staple 99e because, inherently by convention, in a linking position, staple 99e must have one single straight/central portion connecting two loops at both ends of the central portion to link two opposing apices of stent wire shown in Fig. 4F of Goicoechea-'627 and as recited in the independent claims. Further, when deployed in a blood vessel in a linking position, it is undesirable to have one loop of staple 99e sticking radially inward to hinder a blood flow or sticking radially outward to injure a blood vessel wall. Therefore, two loops of staple 99e must each receive one of two opposing wire and one loop of staple 99e will not receive both opposing apices of the stent wire shown in Goicoechea-'627's Fig. 4F.

Alternatively, if not inherently, the configuration of a staple in a **linking position** is well-known (please see **Graf-US Pat. 3,751,961's Figs. 8-9**, which show **staple 82** links **wire 88** and **wire 92**, or **Conta et al.-US Pat. 3,751,961's Fig. 21**, which shows staple 159 also in a linking position or **Jarrett et al.-5,342,395's Fig. 2**, which shows staple 12), it would have been obvious to one of ordinary skill in the art at the time of the invention to link two opposing apices of stent wire shown in Goicoechea-'627 as recited in the independent claims.

2. The Applicant (Argument, page 5, paragraph 1) agreed and admitted that an endoluminal prosthesis must be flexible for its deployment along a tortuous path of blood vessels but argued that " ... it is clear that conventional staples used in a conventional office stapler are unsuitable for insertion into aortic arteries or are flexible enough for deployment through a tortuous path of blood vessels (Argument, page 5, second paragraph)".

In response, please notice that the mention of a staple in an office environment is just one way to relate how a staple is configured in a linking position. It was not meant that a staple in an office environment must be used with Goicoechea's prosthesis. It is not important that if a staple in an office environment must be used in Goicoechea's prosthesis, but it is of essential that inherently or obviously, in a linking position, Goicoechea-'627's staple is configured or shaped as recited in the claims. From a staple used in an office environment to staples disclosed in the mentioned above references, it is clear that at least the configuration or shape of a staple in a linking position as recited in the claims is well known and well established.

In addition, at least because it is well known in the art to have a flexible stent for easy deploying the stent in tortuous blood vessels (also admitted by the Applicant: see Argument, page 5, paragraph 1), at least it would have been obvious to one of ordinary skill in the art to provide some clearance between staple 99e and staple's loops of Goicoechea-'627 to allow relative movements between the staple's loops and two opposing apices of Goicoechea-'627's stent wire and make the stent flexible along a tortuous blood vessel.

3. The Applicant also argued that : "not only has the Examiner's Answer failed to show that Goicoechea's prosthesis necessarily uses conventional office staples to form the links

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connecting the hoops together, the intended use of the prosthesis makes it extremely improbable, if not impossible, that such a case (Argument, page 5, second paragraph)."

In response, because it is well known in the art to have a flexible stent for easy deploying the stent in tortuous blood vessels (also admitted by the Applicant: see Argument, page 5, paragraph 1), at least it would have been obvious to one of ordinary skill in the art to provide some clearance between staple 99e and staple's loops of Goicoechea-'627 to allow relative movements between the staple's loops and two opposing apices of Goicoechea-'627's stent wire and make the stent flexible along a tortuous blood vessel.

4. The Applicant further argued that: "The office has failed to show an example, which existed at the time of the invention, of a connection between a staple and two wires whereby two loops of the staple, on its opposing ends, each hold a separate one of the two wires (Argument, page 8, first 4 lines of second paragraph)".

In response, the Applicant is requested to look at other references also clearly show staples in a **linking position** having one **single straight portion/central portion connecting two loops at both ends of the straight/central portion**, for example, please see **Graf-US Pat. 3,751,961's Figs. 8-9**, which show **staple 82** links **wire 88** and **wire 92**.

II. Rejection of Claims 21, 23-25, 28, 32, 34-36 and 39 as Being unpatentable over Goicoechea or Goicoechea in View of Lau.

As admitted by the Applicant, the rejection of claims 21, 23-25, 28, 32, 34-36 and 39 rely on the rejection 102(b) or 103(a) of independent claims 18 and 29. If the 102(b) or 103(a) of

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independent claims 18 and 29 is proper, the 103(a) rejection of claims 21, 23-25, 28, 32, 34-36 and 39 should be maintained.


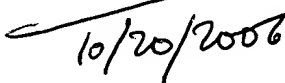
Conclusion

The Examiner has been trying the best to explain the Office's position as to the reason why the claims should be rejected.

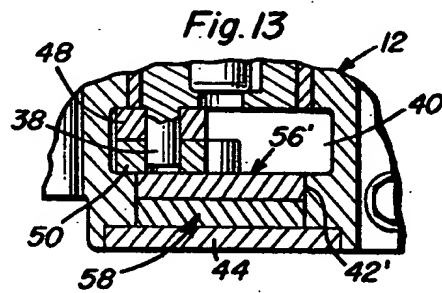
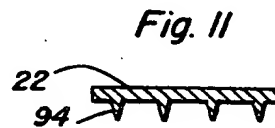
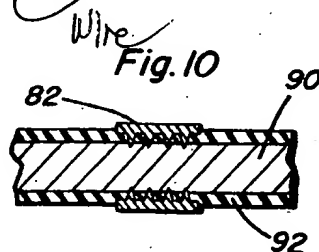
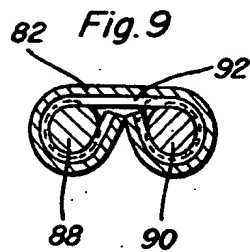
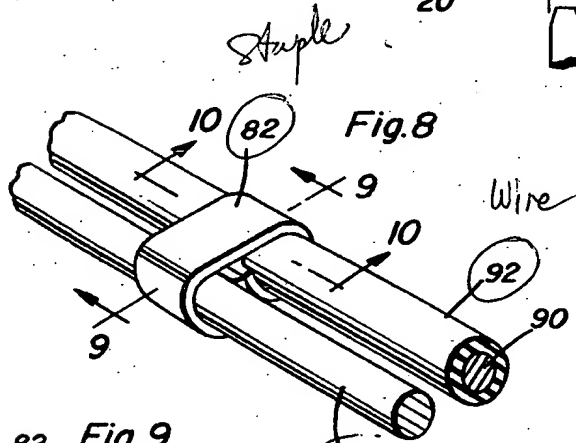
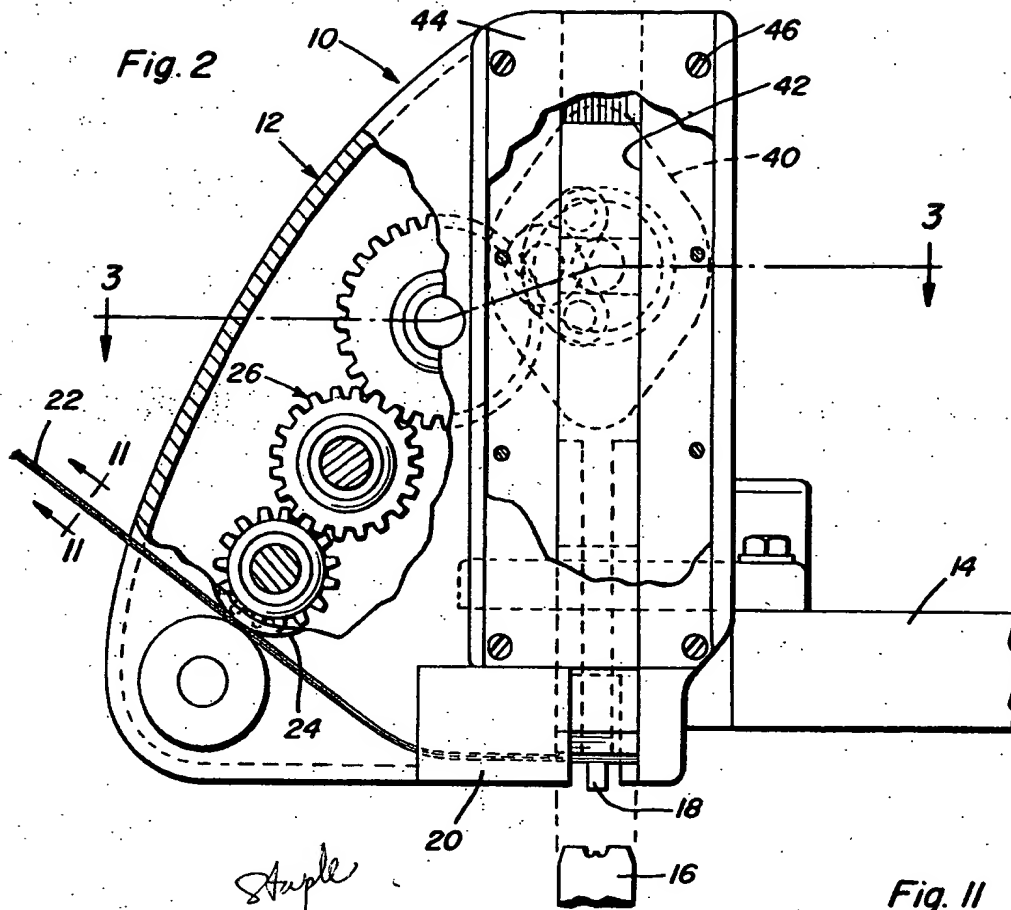
Any further arguments or responses would unfortunately further delay the prosecution of the present invention.

The case of the present invention is forwarded to the "Board of Appeals and Interference" for further consideration.

Attachement: 1. Sheet 2 of 3 of US-3,751,961 showing staple 82 in Figs. 8-9
2. Sheet 7 of 21 of US-4,304,236 showing staple 159 in Fig. 21
3. sheet 1 of 3 of US-5,342,395 showing staple 12 in Fig. 2

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